

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Scott C. Harris)
Appl. No.	:	09/690,002)
Filed	:	October 16,2000)
For	:	AUTOMATIC MAIL REJECTION FEATURE)
Examiner	:	Jerry Dennison)
Group Art Unit:	:	2142)
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Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant's Brief On Appeal

Sir:

In response to the notice of non-compliant appeal brief mailed December 8, 2006, Applicant herewith resubmits this Brief on Appeal that was originally filed on June 30 2006, to perfect the Notice of Appeal which was originally filed on January 31, 2005.

The Appeal Brief fee was already paid.

No further fees are necessary.

The present application qualifies for small entity status under 37 C.F.R. § 1.27.

The headings and subject matter required by rule 41.37 follow.

Real Party In Interest

The inventor, Scott C. Harris, is the real party in interest.

Related Appeals and Interferences

There are no known related appeals and/or interferences.

Status of Claims

Claims 1-7, 14-16, 21 and 23-24 are pending. Claims 8-13, 17-20 and 22 have been canceled. Each of the remaining claims are appealed herein.

Status of Amendments

No amendment was filed after the final rejection.

Summary of Claimed Subject Matter

Claim 1 requires receiving an e-mail message, which is described in the specification page 3 lines 11-15, shown in Figure 1. Claim 1 further defines displaying information about the message in a way that allows all of deleting the message in one of three different ways: without detecting whether it is spam or not; while indicating that it is spam, or while indicating that it is not Spam. This is shown in Figure 1 respectively by the three buttons 107, 111, and 112, and described in the specification page 4, lines 15-17, and 23-24.

Claim 14 requires a display that displays a number of e-mails, shown generally at Figure 1, item 110, and described in the specification page 3 lines 11-17. Claim 14 also requires a first control that selects deleting the e-mail while indicating that it is spam,

and a second control selecting deleting the e-mail while indicating that it is not spam.

The controls 111 and 112 in Figure 1, described in the specification page 4 line 17 and page 4 line 23 provide support for this feature.

Claim 21 defines determining a plurality of characteristics of an unwanted message, see for example page 4 lines 17-22. A list is formed with the plurality of characteristics, see page 7 line 19 through page 8 line 9. A numerical score for incoming e-mails is obtained by comparing incoming messages and determining commonalities between the incoming message in the list. See page 8 line 21-page 9 line 11. The message is characterized as being unwanted if within a range, see page 9 line 12-24. If the e-mail is determined to be unwanted, it is restricted, see page 10 lines 1-2.

Claim 23 cites a method of obtaining an e-mail message, see generally page 3 lines 11-17. The user interface, shown as 102 in Figure 1 allows deleting the message in all of three different ways, see the buttons 107, 111 and 112 in Figure 1, described in the specification page 4, lines 15-17, and 23-24..

Grounds of Rejection to be Reviewed on Appeal

Are claims 14-16 properly rejected under 35 USC 101 as being directed to non-statutory subject matter?

Is Claim 14 properly rejected under 35 USC 102(e) based on Pang?

Is Claim 14 properly rejected under 35 USC 102(e) based on Horvitz?

Are claims 1-7, 14, 23, 24 properly rejected under 35 USC 103 based on AAPA in view of Pang?

Are claims 1-7, 14, 23, 24 properly rejected under 35 USC 103 based on AAPA
in view of Horvitz?

Argument

Rejections Under Section 101

Claims 14-16 stand rejected as allegedly being directed to non-statutory subject matter. This contention is respectfully traversed. The claim is objected as not being a physical thing. However, the "program" as claimed clearly is not a disembodied sequence of events. Rather, claim 14 defines a display portion that displays a plurality of emails. Claim 14 defines a plurality of controls. The controls allow selecting emails from the display, and allow certain operations on those emails.

Since there is a display and controls, the combination MUST represent a physical thing. The claimed sequence of events clearly interacts with the real world. A display is a real thing – it cannot in any sense be thought of as "nonstatutory".

Claim 14 also controls deleting emails, and as such, changes something from one state to another. As such, this represents a statutory claim under 35 USC 101.

Art Rejections

Initially, and with all due respect, the continually-varying rejections which have been made in this case have a common reliance on a single faulty premise: that somehow the claimed "delete as not spam" control is inherent.

Note that the claims require different ways of deleting the message. For example, taking claim 1 as representative, it defines displaying information about the e-mail message in allow in a way that allows:

- 1) deleting the message without indicating whether it is spam or not,
- 2) deleting the message while indicating that it is spam and
- 3) deleting the message while indicating that it is not spam.

This means there are three different ways of deleting the message, two which indicate something about the content of the message (spam, not spam), one which does not indicate anything about the message's content. In order to meet this claim, the reference must disclose or suggest all three of these ways of deleting the message.

The rejection has never shown these three different ways of deleting the message.

In fact, no reference, and no showing, has ever shown 3) above – deleting the message while indicating that it is not spam.

The rejection has shown pieces of this in the prior art, but has never shown all three of these in the prior art. The contention that this is inherent within the prior art is quite simply speculation that uses hindsight in the attempt to bolster the conclusion.

The contention that "delete as not spam", as set forth in various claims is inherent in the prior art is respectfully traversed. The prior art does not disclose any functionality of deleting, while indicating that a message is NOT SPAM. It may delete without indicating whether message is or is not spam, but does not delete while indicating that the message is not spam.

Moreover, there is an advantage that follows from deleting while indicating that the message is not spam. A system monitoring the deletions can learn from the deletions. It can learn from a message that was deleted as not being spam, that the message was in fact a desirable message, not a spam message. However, if the user does not want to be bothered with indicating whether the message is spam or not, the regular old "delete" control can be used. This technical effect is quite simply not disclosed or possible using anything from the prior art.

REJECTIONS UNDER Section 102

Claim 14 stands rejected under 35 U.S.C. 102(b) as allegedly being unpatentable over Pang. This contention is respectfully traversed for reasons set forth herein, and it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a *prima facie* showing of unpatentability.

Nowhere does Pang in any way teach or suggest the two claimed controls -- one which enables deleting while indicating that the e-mail is spam, and the other which deletes the e-mail "while indicating that said e-mail is not spam". There is no deletion control in Pang that indicates that the email is not spam.

The rejection refers to figure 4 and 5 column 8 line 63 through column 9 line 13. Column 8 lines 63 describes how the user can view the pending e-mails, and column 9 lines 5-6 describe that the user can delete the desired e-mails, archive them or the like. In one embodiment, the spam is deleted from the user's inbox. The delete button, therefore, simply deletes without indicating whether the e-mail is spam or not spam – it

simply "deletes". Nowhere does Pang teach deleting while indicating that the e-mail is not spam.

The rejection then refers to column 10 lines 30 - 36 which discusses removing spam. From this, the rejection somehow reasons that the user could be able to remove the message while indicating that it is NOT spam. This is quite simply not stated anywhere in Pang. Removing is different than indicating. In fact, Pang teaches nothing about an e-mail button or an e-mail display to "delete as not spam". The buttons in figure 5 include delete, and no spam. The no spam button 521, however, might indicate that something IS spam. The delete button certainly does not indicate that the item being deleted within Pang that it is, or is not, spam. Both spam and non-spam can be deleted with the delete button.

Since Pang does not have all the claimed elements, it does not anticipate claim 14.

Claim 14 is rejected as allegedly being anticipated by Horvitz. This contention is respectfully traversed. There are no controls in Horvitz that meet the claim limitations. The rejection refers to the first and second "controls" shown in figure 2, as 223 and 227. First, however, note that 223 is a folder, as is 227. A folder is not a control, as required by the claim. Horvitz does not teach a control as indicated by the rejection, but rather teaches an mail classifier, that classifies mail as being legitimate mail, or spam email. There is no teaching or suggestion of a control that controls, as claimed, delete as not spam. Rather, figure 2 simply shows a mail classifier. It teaches nothing about any controls – much less controls for deleting while indicating that the message is not spam.

Rejections Under Section 103

Claims 1-7, 14, 23, 24 are rejected based on AAPA in view of Pang. This contention is respectfully traversed. Specifically, Pang teaches a system which enables identifying spam messages to be removed, as noted in its specification. However, Pang does not define displaying information about the message in a way that allows three different ways of deleting (and, must have all three): 1) without indicating whether it is spam or not; 2) while indicating that it is spam or 3) while indicating that it is not spam, quoting from claim 1.

Pang teaches a system where a message can be deleted as being spam. However, there is no way to delete the message while indicating that it is not spam. The cited sections within Pang are illustrative. For example, column 7 line 43 through column 9 line 22 explains that the "no spam" button enables removing the e-mail message and carrying out certain other actions. Nowhere, however, is there any teaching or suggestion of, not only a delete as spam button, but also a delete without indicating, and a delete-as-not-spam, as required by the claim. Simply having a delete as spam button does not suggest these other parts. The ability to delete unsolicited e-mails while indicating them as being spam is only half the puzzle-the present application recognizes that the system can also learn from e-mails that are desired / not spam emails. Therefore, deleting as not spam produces an additional variable which is nowhere taught or suggested by AAPA in view of Pang.

Therefore, claim 1 should be allowable along with the claims that depend therefrom.

Claim 14 defines a plurality of controls including first control that deletes while indicating that it is spam, and a second control which selects deleting while indicating that it is not spam. This allows the system to learn from both actions, both from the spam action and from the non-spam action. As described above, this is not taught or suggested by AAPA in view of Pang.

Claim 23 defines a method with a user interface that allows selection of all three things: to delete without indicating whether spam or not, to delete while indicating that it IS spam, and to delete while indicating that the message does not indicate spam. This combination is not taught or suggested by the cited prior art.

Claims 1-7, 14, 23 and 24 stand rejected over the admitted prior art in view of Horvitz. As described above, Horvitz simply teaches separate folders for different kinds of spam. Horvitz also teaches classification. It does not teach controls for deleting as spam or deleting as not spam. The arguments bridging pages 10-11 of the official action are quite simply based on hindsight. The argument apparently attempts to contend that since standard e-mail programs include a delete button, that these delete buttons must be able to choose spam or not Spam. Quite simply, this is hindsight, since what it was never taught or suggested by Horvitz. It attempts work backwards from what is taught by the present application.

Moreover, the controls for deleting are an important part of the claimed subject matter. The rejection tacitly admits that Horvitz never taught any deleting controls, but instead tries to bootstrap from the hypothetical functionality of "standard e-mail programs". The rejection attempts to contend that somehow the delete function from standard e-mail programs could be applied to the different folders of Horovitz in exactly

the claimed way. This is nothing but speculation. This is not based on anything in the prior art, but is rather based on some fanciful interpretation of how a hypothetical combination could be made between an e-mail classifier, and a hypothetical delete program. Nowhere does Horvitz teach anything about how to delete, or controls to delete. The controls to delete are important parts of these claims such as claim 1, 14 and 23. Without even suggestion a delete function, Horvitz certainly could not render this obvious.

As a final issue, the undersigned respectfully points out that each rejection in this case has changed at least one ground on which the rejection is based, against identical, or almost identical claims. This is completely antithetical to the goal of the patent system, and certainly antithetical to the MPEP's requirement that an examiner make their best rejection. The continually-changing grounds for rejection ITSELF demonstrates the unobviousness and novelty of the claimed system: since the patent office seems to be unable to maintain a constant ground of rejection.

Moreover, it is respectfully suggested that the Patent Office's failure to maintain a consistent ground of rejection violates the applicant's due process rights, since it demonstrates that the application is not receiving a consistent and fair examination.

In summary of the above, the Patent Office has failed to meet their burden of providing a *prima facie* showing of unpatentability. For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance and that the Examiner's rejection should be reversed.

No fees are necessary for this resubmission.

Respectfully submitted,

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CLAIMS APPENDIX - ALL CLAIMS ON APPEAL

1. A method, comprising:

receiving an electronic mail message;

displaying information about the electronic mail message in a way that allows all of deleting the message without indicating whether it is spam or not, deleting the message while indicating that it is spam, or deleting the message while indicating that it is not spam.

2. A method as in claim 1 further comprising storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database.

3. A method as in claim 1 wherein said deleting while indicating updates rules in a rules database.

4. A method as in claim 3 wherein said rules include information about fields from said electronic mail message.

5. A method as in claim 3 wherein said fields include at least a sender of the e-mail message, text of the e-mail message, and a subject of the e-mail message.

6. A method as in claim 5 wherein said fields also include a domain of a sender of the e-mail message.

7. A method as in claim 3, wherein said fields include links within the e-mail message.

14. An e-mail program, comprising:

a display portion which displays a plurality of e-mails;
a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam.

15. A program as in claim 14, further comprising displaying a likelihood of spam coefficient which indicates, on a weighted scale, a likelihood that the associated message represents spam.

16. A program as in claim 14, further comprising displaying a control which allows deleting an e-mail without indicating or not indicating whether said e-mail represents spam.

21. A method, comprising:

determining a plurality of characteristics of an unwanted message;
forming a list with said plurality of characteristics;

forming a numerical score of an incoming message by comparing said incoming message with said list and determining commonalities between said incoming message and said list;

defining said message as likely being unwanted if said numerical score is within a predetermined range; and

taking an action to restrict said message based on said defining.

23. A method, comprising:

obtaining an electronic mail message; and

a user interface that displays information about said electronic mail message,

and which user interface allows a selection to all of:

A) delete the message without indicating whether or not the message represents spam,

B) delete the message while indicating that the message does indicate spam, or

C) delete the message while indicating that the message does not indicate spam.

24. A method as in claim 23, further comprising a database of information indicating likelihood of spam, and wherein said delete while indicating that the message does indicate spam updates information in said database.

Evidence Appendix: None

Related Proceeding Appendix: None